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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,753	08/02/2006	Vincenzo Di Giorgio	09952.0053	5633
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER DOAN, PHUOC HUU	
			ART UNIT 2617	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,753

Applicant(s)

DI GIORGIO ET AL.

Examiner

PHUOC DOAN

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38, 40, 42-55, 57, 58 and 60-72 is/are rejected.
- 7) ☒ Claim(s) 39, 41, 56 and 59 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/25/2009 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-38, 40, 42-55, 57-58, 60-72 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-38, 40, 42-55, 57-58, 60-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis (US Patent No: 6,542,733) in view of Rogers (US Patent No: 6,360,108).

As to claim 37, Dennis discloses a method for processing user indicators stored in a terminal for telecommunications networks (See Abstract “Users add telephone number and configure profile information on the wireless device which linked to the wireless network”), comprising: selectively organizing said indicators in one of a plurality of configurations (page 3, lines 20-40 "allows the user to enter telephone numbers or other information"), said plurality comprising at least a first and a second configuration (col. 4, lines 5-40 "the personal profile system can be configured so that the user can select special code or long distance service"), said first configuration comprising identifiers organized with the insertion of an identification code of an operator selected by the user of the terminal and said second configuration comprising identifiers organized with the inclusion of at least one of a country prefix and a local prefix (col. 4, lines 25-40, col. 5, lines 23-51 “user can select to have a default setting which is stored the number in memory or user could assign special codes of country and a local, for example: 01; 995-555-1234”). However, Dennis does not

disclose a country prefix and a local prefix; modifying the user identifiers by including an identification code of an operator selected by the user of the terminal or at least one of a country prefix and a local prefix; and wherein the modified identifiers are stored in the terminal.

In the same field of endeavor, Rogers discloses a country prefix and a local prefix (See col. 6, TABLE 1 “provided a country prefix and a local prefix”; col. 6, lines 1-64); modifying the user identifiers by including an identification code of an operator selected by the user of the terminal or at least one of a country prefix and a local prefix (col. 6, lines 1-64, and col. 7, lines 15-52); and wherein the modified identifiers are stored in the terminal (col. 3 through col. 4, lines 60-37 “a prefix storage area 128 of mobile device is used to store one or more prefixes that may be predefined by the telephone service provider, or added by the user”). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a country prefix and a local prefix as taught by Rogers to the system of Dennis in order to offer the advantage of mobile telephone users when they are traveling.

As to claim 38, Dennis further discloses the method as claimed in claim 37, wherein said identification code of an operator is the identifier of a long

distance operator (col. 4, lines 6-10).

As to claim 40, Rogers further discloses the method as claimed in claim 37, comprising generating said identifiers organized in said at least a first and a second configuration by means of an if/then mechanism in which the then function implements at least one function selected from the group of: adding said identification code to the identifier to be organized in said first configuration (col. 3, lines 10-22), and associating with the identifier to be organized at least one of a country prefix and a local prefix in said second configuration (col. 6, lines 1-65).

As to claim 42, Dennis further discloses the method as claimed in claim 37, comprising detecting the location of said terminal and of switching said identifiers between said first configuration and said second configuration according to the detected location of the terminal (col. 6, lines 28-40 “determines the user’s current location, such as by identifying a particular cell/base station or sector that is in communication with the user”).

43. The method as claimed in claim 37, comprising organizing identifiers originally consisting of 7 or 8 digits by adding the digit 0, a local prefix

identified by the user and said identification code to the identifier organized in said first configuration, and by adding the character "+", a country prefix and a local prefix provided by the user to the identifiers organized in said second configuration (col. 4, lines 65-67, col. 5, lines 20-39, col. 6, lines 10-65 “software programming designed choice adding character “+” or # in associated a country and local prefix as the same feature of programming of the automatic pre-pending; for example: user can enter the number of digits (e.g., 5 digits, 7 digits, etc.)”).

As to claim 44, Rogers further discloses the method as claimed in claim 37, comprising organizing identifiers originally consisting of 10 or 11 digits by adding said identification code to the identifiers organized in said first configuration, and by removing a "0" in the first position and adding a country prefix to the identifiers organized in said second configuration (col. 4 lines 65-67, col. 5, lines 20-37, col. 6, lines 34-60 “ software programming designed choice adding or removing “0” and adding a country and local prefix”).

As to claim 45, Rogers further discloses the method as claimed in claim 37, comprising organizing identifiers originally consisting of 12 or 13 digits by

replacing the second and third digits with said identification code in the identifiers organized in said first configuration, and by removing a "0" in the first position and the second and third digits, replacing them with an international prefix in the identifiers organized in said second configuration (col. 6, lines 1-65).

As to claim 46, 48, Dennis further discloses the method as claimed in claim 37, comprising organizing identifiers originally comprising the code "00" by replacing the third and fourth digits with said identification code in the identifiers organized in said first configuration (col. 4, lines 10-26), and by removing the first four digits and adding the symbol "+" to the identifiers organized in said second configuration (col. 4, lines 65-67, col. 5, lines 20-37, col. 6, lines 34-60 " software programming designed choice adding or removing "00" and adding a country and local prefix").

As to claim 47, the combination of Dennis and Rogers further disclose the method as claimed in claim 37, comprising organizing identifiers originally comprising said country prefix by removing said country prefix and including said identification code in the identifiers organized in said first configuration (col. 5, lines 20-37 of Rogers), and by leaving the identifier

unchanged in the case of said second configuration (col. 6, lines 30-40 “the network determines the user’s current location” of Dennis).

As to claim 49, Dennis further discloses the method as claimed in claim 37, comprising: when indicators corresponding to special services are present (col. 4, lines 15-40), leaving the identifier unchanged without carrying out the configuration in said at least a first and at least a second configuration (col. 4, lines 15-40).

As to claim 50, Dennis further discloses the method as claimed in claim 37, wherein said plurality of configurations comprises a network call configuration with an associated identification code consisting of a code for activation of the call by the network designed to enable said terminal to be called back by the corresponding network (lines 1-54).

As to claim 51, Dennis further discloses the method as claimed in claim 50, wherein said call activation code is associated with a prepaid roaming service (15-26).

Art Unit: 2617

As to claim 52, Dennis further discloses the method as claimed in claim 37, wherein said plurality of configurations comprises a debiting configuration with an associated identification code consisting of a billing code (col. 4, lines 1-10), such as a code for configuring the number of said terminal for making calls to be debited to the called user (col. 4, lines 30-40 “the personal profile system can be configured so that the user can select which portion of the destination telephone number is to be use”).

As to claim 53, Dennis further discloses the method as claimed in claim 37, wherein said plurality of configurations comprises an authorization configuration with an associated identification code consisting of a code which authorizes calls from two or more lines associated with a terminal or with a corresponding card of the SIM type (col. 3 lines 41-67).

As to claim 54, this claim specifies an apparatus necessary to perform the method steps as specified in claim 1 and is therefore rejected for the same reasons.

As to claim 55, claim is rejected for the same reasons as set forth in claim

38.

As to claim 57, claim is rejected for the same reasons as set forth in claim

40.

As to claim 58, claim is rejected for the same reasons as set forth in claim

41.

As to claim 60, claim is rejected for the same reasons as set forth in claim

43.

As to claim 61, claim is rejected for the same reasons as set forth in claim

44.

As to claim 62, claim is rejected for the same reasons as set forth in claim

45.

As to claim 63, claim is rejected for the same reasons as set forth in claim

46.

Art Unit: 2617

As to claim 64, claim is rejected for the same reasons as set forth in claim 47.

As to claim 65, claim is rejected for the same reasons as set forth in claim 48.

As to claim 66, claim is rejected for the same reasons as set forth in claim 49.

As to claim 67, claim is rejected for the same reasons as set forth in claim 50.

As to claim 68, claim is rejected for the same reasons as set forth in claim 51.

As to claim 69, claim is rejected for the same reasons as set forth in claim 52.

As to claim 70, claim is rejected for the same reasons as set forth in claim 53.

As to claim 71, Dennis further discloses a card of the SIM type for a telecommunications network terminal “depend on the subscriber to service provider with provide SIM type or PIN for authorization access network”, wherein said card hosts, at least partially, at least one of said storage area and said processing capacity for a terminal according to any one of claims 54 to 70 (col. 4, lines 63 to col. 5, lines 21).

As to claim 72, Dennis further discloses a computer program product which can be loaded into the memory of an electronic computer (col. 6, lines 15-20), containing portions of software code for implementing the method according to any one of claims 37 to 53 (col. 4, lines 63 to col. 5, lines 21).

Allowable Subject Matter

3. Claims 39, 41, 56, 59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUOC DOAN whose telephone number is (571)272-7920. The examiner can normally be reached on 10:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LESTER KINCAID can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2617

/PHUOC DOAN/

04/30/09

/Lester Kincaid/

Supervisory Patent Examiner, Art Unit 2617